

Applicants: Andrew R. Marks and Steven O. Marx  
U.S. Serial No.: 09/766,944  
Filed: January 22, 2001  
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- I. claims 1-6 and 19-21, drawn to a method of preventing migration of a cell;
- II. claims 7-13, drawn to a method of identifying a chemical compound that inhibits cellular migration;
- III. claims 14-16, drawn to a chemical compound; and
- IV. claims 17 and 18, drawn to a method for preparing a composition.

The Examiner alleged that the inventions are distinct, each from the other because of the following reasons. The methods of Groups I, II and IV differ in the method objectives, method steps and parameters and in the reagents used. Inventions of Group III and Groups I, II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP §806.05(h)). In the instant case the chemical compound of Group III can also be used in all of the methods of Groups I, II and IV. The Examiner concluded that because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

In ~~response~~ to the restriction requirement, applicants hereby elect, with traverse, to prosecute the invention of Group I,

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claims 1-6 and 19-21, drawn to a method of preventing migration of a cell.

Applicants note that 35 U.S.C. §121 states, in part, that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." [Emphasis added]. Applicants request that the restriction requirement be withdrawn in view of the fact that the claims of the Groups I-IV are not independent.

Under M.P.E.P. §802.01, "independent" means "there is no disclosed relationship between the ... subjects disclosed, that is, they are unconnected in design, operation, or effect... ." The claims of Groups I-IV are related in that they are drawn to methods of preventing migration of a cell, methods of identifying chemical compounds that inhibit cellular migration, compounds identified by those methods, and methods of preparing compositions comprising said compounds.

Applicants therefore respectfully assert that two or more independent and distinct inventions have not been claimed in the subject application because the groups are not independent under M.P.E.P. §802.01.

Additionally, applicants point out that under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper

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requirement for restriction, namely (1) the inventions must be independent and distinct; AND (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants maintain that there would not be a serious burden on the Examiner if restriction were not required. A search of prior art with regard to any one of Groups I-IV would necessarily identify art for other Groups. Since there is no serious burden on the Examiner to examine Groups I-IV in the subject application, the Examiner must examine the entire application on the merits.

Accordingly, in view of the preceding remarks, applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.



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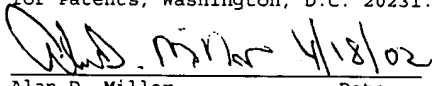
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No fee is deemed necessary in connection with the filing of this Communication. However, if a fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

 4/18/02

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